

REMARKS/ARGUMENTS

Claims 38-49 remain in this application.

Applicants respectfully traverse the rejection of Claims 38-49 under 35 U.S.C. § 103(a) as being unpatentable for obviousness over Bacon et al (US Patent No. 6,027,062) in view of Isoard (US Patent No. 4,206,883).

Applicants submit that one would not be motivated to combine the teachings of Bacon and Isoard as proposed. Optical fiber such as is employed in applicant's invention and in the Bacon reference is much stiffer and more brittle than the yarns which are employed in the Isoard reference.

The Examiner submits that "Isoard teaches activating an aspirator 13 mounted on a carriage 17, to obtain the fiber at a first location 3, 4 (position I) and moving the fiber to a second location (position II) to thread the fiber through a component 7, 8 in the fiber draw process (Fig. 3, col. 4 line 58 to col. 5 line 28)."

Applicants respectfully disagree. The words "fiber" and "optical fiber" are never mentioned in Isoard. The teaching of Isoard relates to methods for transferring a plurality of textile yarns, not a single strand of optical fiber. As explained above, for this reason alone (the difference between a plurality of yarns and a single strand of optical fiber) one would not combine the teachings of these two references. Optical fiber is an extremely fine (about 150 microns diameter) and stiff material, while yarn is considerably thicker and much more flexible. Optical fiber is also comparatively much more delicate than yarn, e.g., optical fiber if bent can be easily broken, while the same is not true of textile yarns. Thus, optical fiber is much more easily damaged than textile yarns.

The Examiner asserts that Bacon discloses an apparatus and method of threading a moving length of fiber through a component in an optical fiber draw, optical fiber winding or optical fiber testing process. The Examiner admits that Bacon fails to teach the positioning device being an aspirator, but submits that "It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the positioning device of Bacon to include an aspirator to hold the fiber as suggested by Isoard, to hold the fiber while transferring and threading the fiber without causing damage to the fiber."

Applicants respectfully disagree. Applicants submit that even if, assuming arguendo, the references were properly combinable, such a combination would clearly not result in applicants invention. First, contrary to Examiner's suggestion, Isoard clearly does not move aspirator 13 from a first location 3,4 to a second location to thread the fiber (yarn) through either of components 7 or 8. This concept is neither shown in Fig. 3 nor in the passage referred to by the Examiner (col 4 line 58 to col 5 line 28).

Instead, the portion of Isoard referred to by the Examiner indicates that the aspirator 13 is moved from the first location at one end of the slide rail 11 to a second location at the other end of the slide rail 11 (notably not threading a component in an optical fiber draw process). At this point "The positioning of each yarn on its wind-up spindle 7 or 8 is effected by means of the catching nozzle 16, as in the preceding case." In particular, the preceding case, which is described at column 4, lines 32-35, involves having an operator manually anchor the yarns to their respective spindles after they have been seized by the catching nozzle 16. Consequently, it is clear that, even if the references were combinable as proposed by the Patent Office, such a combination would not result in applicant's claimed invention, as the aspirator employed in Isoard is not utilized to thread an optical fiber through a component in a optical fiber draw process.

Further, one of skill in the art would not be motivated to utilize the aspirator from Isoard as the mechanical positioning device in Bacon, as an aspirator is already employed in Bacon for a completely different purpose, namely, to provide tension on the fiber so that the mechanical armature can feed the fiber through the winding process. Thus, modifying the teachings of Bacon would destroy the intended function of the aspirator already present in Bacon, namely to remove waste fiber.

Lastly, merely replacing the positioning device in Bacon with the aspirator of Isoard would likely not work, as the pressure employed in Isoard is likely much less than that of the aspirator employed in Bacon due to the fact that it is only working with yarn which is considerably more flexible and of larger diameter than optical fiber. Consequently, the other aspirator 80 in Bacon would simply continue to draw fiber such that the aspirator from Isoard would likely not be able to capture any of the fiber and the device would not work. In this respect, the Examiner has indicated only that the device in Isoard should be substituted for the positioning device in Bacon.

The Examiner does not indicate what happens to the already present aspirator 80, or how the two aspirators will work together with one another.

To establish a prima facie case of obviousness, the Board must, inter alia, show "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1598 (Fed. Cir. 1988). "The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved." Kotzab, 217 F.3d at 1370, 55 USPQ2d at 1317.

("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.); in re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant).

The closest the Examiner comes to indicating any motivation for combining the teachings of Isoard and Bacon is in the latest final rejection, where the Examiner indicates that "The aspirator as taught by Isoard will cause less damage to the fiber." Applicants submit that there is no teaching anywhere in Isoard that the aspirator in Isoard will cause less damage than the positioning device disclosed in Bacon, nor is there any such discussion in Bacon. Thus, clearly the Examiner is not able to point to any statement in the prior art that would provide motivation to combine the references in the manner proposed. Instead, the Examiner appears to be opining on knowledge of one of ordinary skill in the art. However, as evidenced by the Declaration under 35 U.S.C. §1.132 which is submitted herewith by Kirk Bumgarner (who happens to be one of the inventors of the Bacon process as well as the process of the present invention), an aspirator does not necessarily cause less damage to the fiber. In fact, the method disclosed in Bacon produces optical fiber of the same quality as optical fiber employed using a process as disclosed and claimed by applicants' invention.

Based upon the above amendments, remarks, and papers of record, Applicants believe the pending claims of the above-captioned application are in allowable form and patentable over the prior art of record as there is no motivation to combine the

references in the manner proposed, and even if the references were combinable such a combination would not result in applicants' invention. Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Applicants believe that no extension of time is necessary to make this Reply timely. Should Applicant be in error, Applicant respectfully requests that the Office grant such time extension pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Reply timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension to the deposit account of the undersigned firm of attorneys, Deposit Account 03-3325.

Please direct any questions or comments to Robert L. Carlson at 607-974-3502.

Respectfully submitted,



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